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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,878	11/03/2003	John Renato Mortarelli		2877

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EXAMINER

MENGISTU, AMARE

ART UNIT PAPER NUMBER

2629

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/605,878

Applicant(s)

MORTARELLI, JOHN RENATO

Examiner

Amare Mengistu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The claimed subject matter is not is the specification. In claim 4 ***"The finger tip stylus may be implemented as a single-use, disposable product or as a reusable product with a disposable, single-use adhesive interface."*** ;

In claim 5 ***"The finger tip stylus may be implemented as a single-use, disposable product or as a reusable product with a disposable, single-use adhesive interface"***

In claim 6 ***"The finger tip stylus by design is light weight, less tiresome to use over prolonged periods of time, especially when interfacing with software applications that demand a continuous stream of fine motor user inputs. It is less cumbersome than a finger stylus which surrounds or partly surrounds a finger mechanically using frictional forces or a handheld "pencil-like" stylus typically used with handheld computing devices";***

In claim 7 ***"The finger tip stylus by design is not easily lost or misplaced and does not need to be cradled in the handheld device. It enhances user efficiency by allowing essentially full use of the hand on which it is attached to accomplish other tasks. Compared to a typical "pencil-like" stylus, it additionally frees the user from alternately picking up or putting***

down the device to accomplish other pending tasks. It is by design at least as lightweight and as comfortable to wear as a finger tip stylus that surrounds or partly surrounds the finger and is mechanically attached to the finger tip by frictional forces”;

In claim 8 ***“The instant invention can serve as a user-interface, item-selection tool by providing accurate input positioning information, as a writing implement by pressing the thumb up against the index finger in typical handwriting fashion with a finger stylus attached to the index finger and can provide for two finger “touch typing” on the soft keyboard of a handheld device by attaching one finger tip stylus to the index finger and another to the adjacent finger”.***

Claim Objections

2. Claims 1-8 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Claims should start in capital letter and ends in a period (single sentence). Figure should not be included in the claim. Note the format of the claims in the patent(s) cited.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Schneider** (6,626,598 B2).

5. As to claims 1-8, **Schneider** discloses a adjustable finger stylus including continuous with and supplemented by a contoured base support designed to provide an adhesive bonding interface for either a finger tip or a finger nail (see, col.2, lines 56-67,col.5, lines 5-50), the stylus tip, which is constructed of a suitable durable material, typically a hard plastic is designed to minimize possible damage to the display surface(col.5, lines 5-50), it is typically 10 millimeters in length and approximately 5 millimeters in diameter at its widest part where upon it is supplemented by a contoured base support, similar in size and shape to a hard contact lens of approximately 10 millimeters in diameter and a few millimeters thick (col.6, lines 1-20), when attached directly to part or all of a finger tip when designed to attached to a finger nail the stylus tip is supplemented with more base support as necessary to interface with part or all of a finger nail consistent with the intended implementation (see, col.2, lines 56-67,col.5, lines 5-50). **Schneider** does not exactly teaches that the dimension of the stylus but it is

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within the same range of length and thickness. For the stylus to have certain length and thickness would have been a choice of engineering design depends upon individual.

Thus, size and thickness is not patentable.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amare Mengistu whose telephone number is (571) 272-7674. The examiner can normally be reached on M-F, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on (571) 272-3639. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Amare Mengistu
Primary Examiner
Art Unit 2629

AM

5/15/06